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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,874	09/09/2003	Bill Shapiro	07844-609001	5247

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EXAMINER

PAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/659,874

Applicant(s)

SHAPIRO ET AL.

Examiner

Joseph Pan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/9/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14-17, 19-21, 23-27, 41-44, 46-48, 50-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Bar-Or et al. (U.S. Pub. No. 2003/0237005), hereinafter "Bar-Or".

Referring to claims 14, 41:

Bar-Or teaches:

A method of accessing an electronic document, comprising:

requesting, from a document management system, access at a user location to an electronic document, one or more renditions of the electronic document being stored in a document repository in the document management system (see figure 2b, element 70 'recipient attempts to access object' of Bar-Or);

receiving at the user location an electronic voucher for the electronic document, the electronic voucher being issued by the document management system and including an electronic key operable to decrypt an encrypted rendition of the electronic document (see figure 2b, element 80 'security server sends key to recipient' of Bar-Or); and

using the electronic key of the electronic voucher at the user location to decrypt the encrypted rendition of the electronic document (see figure 2b, element 82 'object decrypted' of Bar-Or).

Referring to claims 15-16:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the document identifier and the reference to the document repository includes a path for accessing the document repository over a computer network (see page 3, paragraph [0025], lines 3-7 of Bar-Or).

Referring to claim 17:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the access policies (see page 2, paragraph [0020], lines 14-18 of Bar-Or).

Referring to claim 19:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the verifying (see page 1, paragraph [0007], lines 7-11 of Bar-Or).

Referring to claims 20, 44:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the access policies (see page 2, paragraph [0020], lines 14-18 of Bar-Or).

Referring to claims 21, 47:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the rights (see page 2, paragraph [0021], lines 11-12 of Bar-Or).

Referring to claims 23-24, 50-51:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the storing (see page 1, paragraph [0011], lines 8-11 of Bar-Or).

Referring to claims 25, 52:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the encryption (see page 1, paragraph [0008], line 1 of Bar-Or).

Referring to claims 26, 53:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the expiration information (see page 1, paragraph [0006], lines 3-4 of Bar-Or).

Referring to claims 42-43:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the document identifier and the reference to the document repository where one or more renditions of the electronic documents are stored (see page 3, paragraph [0025], lines 3-7 of Bar-Or).

Referring to claim 46:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the verifying (see page 1, paragraph [0007], lines 7-11 of Bar-Or).

Referring to claim 48:

Bar-Or discloses the claimed subject matter: a method of accessing an electronic document. Bar-Or further discloses the enabling (see page 2, paragraph [0017], lines 3-4 of Bar-Or).

Referring to claims 27, 54:

Bar-Or teaches:

A method for controlling access to an electronic document, comprising:

receiving at a document management system a request from a user for access to an electronic document at a user location, a rendition of the electronic document being stored in a document repository in the document management system (see figure 2a, element 50 'recipient requests object identified in notification from object server' of Bar-Or);

authenticating the user at the document management system, to verify that the user is authorized to access the electronic document (figure 2a, element 52 'authentication information needed' of Bar-Or); and

if the user is authorized to access the electronic document, creating, at the document management system, an encrypted rendition using the rendition that is stored in the document repository (see figure 2a, element 64 'security server cryptographically protects object and combines object with mobile code security policy and object controls' of Bar-Or);

creating, at the document management system, a voucher including an electronic key operable to decrypt an encrypted rendition of the electronic document; and passing the electronic voucher to the user location (see figure 2b, element 80 'security server sends key to recipient' of Bar-Or).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-9, 11-13, 28-30, 32-36, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Or et al. (U.S. Pub. No. 2003/0237005), hereinafter "Bar-Or", in view of Someshwar (U.S. Pub. No. 2004/0117655 A1).

Referring to claims 1, 28:

- i. Bar-Or teaches:

A method of controlling access to an electronic document, comprising:

receiving at a document management system a request from a first user for an electronic document at a first user location, a rendition of the electronic document being stored in a document repository in the document management system (see figure 2a, element 50 'recipient requests object identified in notification from object server' of Bar-Or);

authenticating the first user at the document management system, using a set of access policies for the electronic document, to verify that the first user is authorized to obtain the electronic document (see figure 2a, element 52 'authentication information needed' of Bar-Or); and

if the first user is authorized to obtain the electronic document, passing an encrypted rendition of the electronic document to the first user (see figure 2a, element 66 'security server sends protected object to recipient' of Bar-Or);

receiving at the document management system a request from a second user for access to the encrypted rendition (see figure 2b, element 70 'recipient attempts to access object' of Bar-Or);

authenticating the second user at the document management system, using the set of access policies, to establish which operations the second user is allowed to perform on the encrypted rendition (see figure 2b, element 76 'satisfactory authentication' of Bar-Or);

creating, at the document management system, a voucher, the voucher including an electronic key operable to decrypt the encrypted rendition of the electronic document; and passing the electronic voucher to a second user location (see figure 2b, element 80 'security server sends key to recipient' of Bar-Or).

However, Bar-Or does not specifically mention that the voucher includes the set of access policies for the electronic document.

ii. Someshwar teaches a secure document printing system wherein Someshwar discloses including the set of access policies for the electronic document (see e.g. figure 4, element 409 'decryption key, access rules' of Someshwar).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Someshwar into the method of Bar-Or to includes the set of access policies for the electronic document in the voucher.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Someshwar into the system of Bar-Or to includes the set of access policies for the electronic document in the voucher, because "Additionally, the document creator has the ability to define access rights for the entire document as well as at the page level." (see page 2, paragraph [0026], lines 9-11 of Bar-Or). Therefore, by including the set of access policies in the voucher, the system has more flexibility to define or re-define the access rights for the documents.

Referring to claims 2, 8-9, 29, 35-36:

Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the encryption (see page 1, paragraph [0008], line 1 of Bar-Or).

Referring to claims 3, 30:

Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the access policies (see page 2, paragraph [0020], lines 14-18 of Bar-Or).

Referring to claims 5, 32:

Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the rights (see page 2, paragraph [0021], lines 11-12 of Bar-Or).

Referring to claims 6, 33:

Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the expiration information (see page 4, claim 10 of Someshwar).

Referring to claims 7, 34:

Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the predetermined number of access operations (see page 4, claim 10 of Someshwar).

Referring to claims 11, 38:

Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the audit trail (see page 1, paragraph [0011] of Bar-Or).

Referring to claims 12, 39:

Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the first user and the second user are the same individual (see figure 1, element 36 'recipient' of Bar-Or).

Referring to claims 13, 40:

Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the first user location and the second user location are identical (see figure 1, element 36 'recipient' of Bar-Or).

5. Claims 4, 10, 18, 31, 37, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Or et al. (U.S. Pub. No. 2003/0237005), hereinafter "Bar-Or", in view of Someshwar (U.S. Pub. No. 2004/0117655 A1), and further in view of Ram et al. (U.S. Pub. No. 2002/0194485 A1), hereinafter "Ram".

Referring to claims 4, 18, 31, 45:

i. Bar-Or and Someshwar disclose the claimed subject matter: a method of controlling access to an electronic document.

However, Bar-Or does not specifically mention that the access policies identify one or more of operations.

ii. Ram teaches a method for the secure distribution of electronic documents wherein Ram discloses that the access rights [i.e., access policies] identify

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one or more of operations with the document (see page 1, paragraph [0014], lines 5-9 of Ram).

iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ram into the method of Bar-Or and Someshwar to use the access rights to identify one or more of operations on the document.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Ram into the system of Bar-Or and Someshwar to use the access rights to identify one or more of operations on the document, because "document protection is a particularly important issue" (see page 1, paragraph [0014], lines 4-5 of Ram).

Referring to claims 10, 37:

Bar-Or, Someshwar and Ram disclose the claimed subject matter: a method of controlling access to an electronic document. They further disclose the PDF (see page 5, paragraph [0068], lines 6-10 of Ram).

6. Claims 22, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Or et al. (U.S. Pub. No. 2003/0237005) in view of Ram et al. (U.S. Pub. No. 2002/0194485 A1).

Referring to claims 22, 49:

i. Bar-Or discloses the claimed subject matter: a method of accessing an electronic document.

However, Bar-Or does not specifically mention PDF (the Portable Document Format).

ii. Ram teaches a method for the secure distribution of electronic documents wherein Ram discloses the PDF (see page 5, paragraph [0068], lines 6-10 of Ram).

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iii. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ram into the method of Bar-Or to use the PDF format.

iv. The ordinary skilled person would have been motivated to have applied the teaching of Ram into the system of Bar-Or to the PDF format, because PDF format is popular and widely-used as a document format.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Pan whose telephone number is 571-272-5987.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

Joseph Pan
January 10, 2007


KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100